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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  840.052.203	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents P O Box 1450, Alexandria VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____		Application Number  09/901,428  First Named Inventor  Whitehouse  Art Unit  2881	Filed  07/09/2001  Examiner  Nguyen, Kiet Tuan
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s) Note: No more than five (5) pages may be provided</p>			
I am the  <input type="checkbox"/> applicant/inventor  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record Registration number <u>58,167</u>  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center;">             Signature            Tuvia Rotberg            Typed or printed name            (212) 486-7272            Telephone number            10/29/2008            Date         </div>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS SEND TO: Mail Stop AF, Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Whitehouse  
Serial No. 09/901,428  
Filed : July 9, 2008  
Examiner: Kiet Tuan Nguyen  
Art Unit: 2881  
For: Multiple Ion Guide  
Attorney Docket No. 840.052.203

October 29, 2008

**VIA EFS**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This Pre-Appeal Request is filed concurrently with a Notice of Appeal in the above-captioned application pursuant to Pre-Appeal Brief Conference Pilot Program of the USPTO.

## **REMARKS**

### **Claim Rejections under 35 U.S.C. 112**

The Examiner has rejected Claims 99 and 115 for not having support in the specification for the limitations “means for providing a delay between the release of pulses of trapped ions and initiation of pulses in the Time-of-Flight instrument” and “means for adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio”

Applicant maintains that the Examiner’s rejection is clearly erroneous as there is adequate support for the above limitations in the current specification and in parent Patent No. 5,689,111.

### **Support for “providing a delay”**

See Applicants’ Preliminary Amendment filed April 18, 2008, page 6, paragraph 5 (“We contend...”) through the paragraph bridging pages 7 and 8 where Applicant argued that there is adequate support for the limitation of “means for providing a delay.” Applicant maintains that the timing the release of an ion packet from an ion guide with the TOF pulse supports the limitation “providing a delay” as to one of ordinary skill in the art the term “delay” describes the time relation between two electronic pulses. See the last paragraph on pg. 8 and full paragraph on pg. 9 of the above-mentioned Preliminary Amendment where Applicant elaborates this point. (Essentially, the Examiner has limited his interpretation of “delay” to the act of delaying, but this technically incorrect given that the term “delay” has more than one meaning. Furthermore, in the art of mass spectrometry, the term “delay” has a specific meaning.)

See the last paragraph on page 9 through the first full paragraph of page 13 of the above-mentioned Preliminary Amendment where Applicant has provided evidence that the timing of one event with another event and a “delay” between two events means exactly the same thing in the art of mass

spectrometry instrumentation as well as in other technical disciplines. Moreover, in the second full paragraph on pg. 13 through the first full paragraph of pg. 15, Applicant has demonstrated that the term "delay" is equivalent to the limitation "timing two pulses" in issued patents.

Applicant also has shown clear support for the limitation "providing a delay" in U.S. Patent No. 5,689,111 – of which the current application is a continuation in part. See last paragraph on pg. 15 through the paragraph bridging pages 17 and 18.

#### Support for "adjusting the delay"

Applicant notes that in an interview at the Patent Office attended by Applicant, counsel and Examiners Nguyen and Kim, it was agreed that the only remaining substantive issue in the case was whether or not the term "*providing a delay*" was supported by the specification. In the subsequent rejection, the Examiner has maintained that there also is no support for the term "*adjusting the delay*." Applicant believes that this rejection will be overcome once it is shown that there is support for the term delay. Nonetheless, Applicant believes that the Examiner's rejection is clearly erroneous as there is adequate support the limitation "adjusting the delay" in the instant application and in that of parent Patent No. 5,689,111.

See for example Applicants' Amendment of December 18, 2007 bottom paragraph of pg. 6 and bridging pg. 7 where Applicant argues that there is adequate support for the term "adjusting the delay."

See also, the Preliminary Amendment of April 18, 2008 last paragraph on pg. 15 through pg. 18 where applicant argues that the term "adjusting the delay" is clearly supported by the disclosure of parent Patent No. 5,689,111.

In addition, it is submitted that "timing two pulses (or events)" encompasses both "providing" and "adjusting" a delay. The verb "timing" implies the action of properly adjusting a delay between two events. Therefore, "timing two pulses" inherently includes "providing a delay between" and "adjusting a delay."

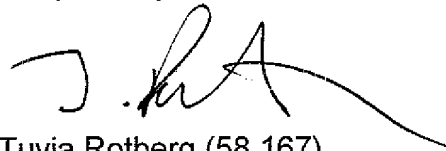
Objected Drawings

The Examiner has objected to the Drawings in the current application for not showing every feature specified in the Claims.

Applicant believes that this objection is clearly erroneous and directs the Examiner to Applicants' remarks in their Amendment of December 18, 2007 (bottom of pg. 3 bridging pg. 4) where Applicant argued that Drawings are not necessary.

In light of the above-cited arguments and evidence, Applicant believes that the Examiner's rejection should be reversed and an interference with U.S. Patent No. 6,285,027 should be declared.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Rotberg', with a long horizontal flourish extending to the right.

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